

Fisher et al.

Appl. No. 09/394,745

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Fisher et al

Appl. No.: 09/394,745

Filed: September 15, 1999

For: **Nucleic Acid Molecules and Other  
Molecules Associated With Plants**

Art Unit: 1631

Examiner: S. Siu

Atty. Docket: 38-21(15454)B

**Response to Restriction Requirement**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Applicant traverses the restriction requirement set out in the Office Action mailed December 19, 2000 which required election of one of the following restricted inventions:

Group I: "claims 8-10, drawn to a microarray containing a set of nucleic acid molecules, the set of nucleic acid molecule not fully characterized, classified in class 536, subclass 23.1";

Group II: "claim 11, drawn to a microarray containing a defined set of nucleic acid molecules, classified in class 536, subclass 23.1".

Applicant elects with traverse Group I.

Groups I and II are classified identically in class 536, subclass 23.1. As such, it would be no more burdensome to carry out a search corresponding to claims 8-11 than any subset thereof. In light of this, Applicants respectfully request that the Examiner withdraw the restriction requirement.

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Linda T. Parker, Registration No. 46,046

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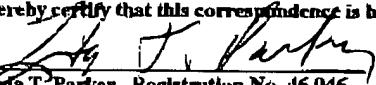
Additionally, the PTO describes the nucleic acid molecules on the microarrays of Group I as not clearly defined because "the subset is recited as containing 1000 nucleic acid molecules, only 100 of them being unique, selected from a group of approximately 400 nucleic acid molecules". Applicant disagrees and believes that the molecules are clearly and distinctly defined.

The PTO further alleges that it would be an undue search burden to perform a search on every combination of 100 nucleic acid molecules selected from a set of 400 molecules." Applicant respectfully disagrees that it would be a burden to examine the nucleic acid molecules in either or both of Group I and Group II. In this regard, the 498 sequences listed in the claims were selected by applicants' representative who personally carried out a computer search of the nonredundant nucleotide database posted by the National Center for Biotechnology Information (NCBI) (<ftp://ftp.ncbi.nlm.nih.gov/blast/db/ntz>) on November 3, 1999. The computer search carried out was a BLASTN query using default parameters on a set of 2921 sequences. It took applicants' representative less than 10 minutes to set up the BLASTN search. After the BLASTN search was completed, Applicants' representative spent approximately 2 hours examining and parsing the BLASTN output with the purpose of selecting those sequences which either had no matches to any sequence in the queried database or which fulfilled other criteria. In this case, the Examiner is being asked to examine only 498 sequences, rather than approximately 3000. Applicants representative submits that even if the Examiner were to search a larger database than the one described above, or use a different search algorithm, the time for running a program is not synonymous with the actual time that an Examiner would have to spend on a search. To further avoid any undue search burden the PTO is encouraged to refer to the preliminary amendment of October 10, 2000 in which applicant submitted a copy of the BLASTN output on a CD-ROM.

Applicants, therefore, submit that the examination of Group I and Group II can be done simultaneously and that the complete examination of the application would be most expeditiously handled by treating all of the pending claims as a single entity.

Applicant further traverses the additional "restriction requirement" where the PTO states:

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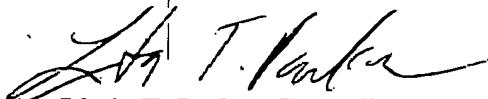
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"If Group I (claims 8-10) is selected, Applicants are required to select one combination for examination."

To the extent that this is not intended to be a further restriction requirement, but merely an election of species for examination, applicant elects the first 100 sequences in the Markush group.

If the Examiner has any questions regarding this application or wishes to propose an amendment to advance the application to issuance, the Examiner is encouraged to contact Applicant's representative at (908) 684-8061.

Respectfully submitted,



Linda T. Parker (Reg. No. 46,046)

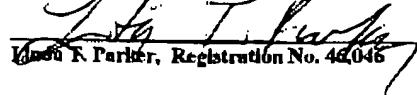
Date April 17 2001

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